

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL A. WILSON,
MARIA MILENKOVIC,
and MILAN MILENKOVIC

Appeal No. 2004-1673
Application 09/641,431¹

ON BRIEF

Before THOMAS, JERRY SMITH, and BARRETT, Administrative Patent Judges.

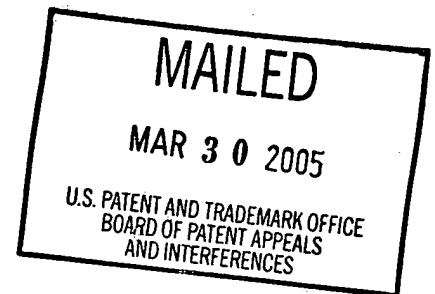
BARRETT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-6, 10-16, and 20-30. Claims 7-9 and 17-19 have been canceled.

We affirm and enter a new ground of rejection.

¹ Application for patent filed August 18, 2000, entitled "Communicating Objects Between Users or Applications," which is based on and claims priority under 35 U.S.C. § 119(e)(1) from U.S. Provisional Application 60/213,318, filed June 22, 2000.



BACKGROUND

The invention relates to a method, a system, and an interface for transferring a note object in the form of a "sticky note" to a recipient by dragging and dropping the note to an icon representing an object recipient.

Claim 1 is reproduced below.

1. A method comprising:

displaying a communications interface in association with a window, said interface including an icon representing a potential object recipient;

enabling a user interface in the form of a sticky note to be annotated in order to pass a note to an intended recipient; and

enabling said note interface to be transferred to said recipient by dragging-and-dropping said note to said icon.

THE REFERENCES

The examiner relies on the following references:

Tang et al. (Tang)	5,793,365	August 11, 1998
de Hond	5,796,395	August 18, 1998
Hogan	5,933,597	August 3, 1999
Fernandes	6,014,135	January 11, 2000

Screen dumps of Microsoft Word 2000 (MS Word), annotated by the examiner: Fig. 1 shows the "About Microsoft Word" window that one gets by clicking on "Help" and then "About Microsoft Word" in Microsoft Word; Fig. 2 shows a Microsoft window with a box having an image of a waterfall, a numeral 200 pointing to the window, and a numeral 210 pointing to the Maximize (middle) button on the upper right hand corner; Fig. 3 shows the reduced size window after clicking the Maximize button with the desktop as the background, a numeral 300 points to the window and a numeral 305 points to the title bar; and Fig. 4 shows the window shifted on the desktop, with a numeral 405 pointing to the title bar.

THE REJECTIONS

Claims 1-3, 11-13, 20-23, and 27-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tang and Fernandes.

Claims 4, 14, and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tang and Fernandes, further in view of de Hond.

Claims 5, 6, 15, 16, 25, and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tang and Fernandes, further in view of screen shots of Microsoft Word 2000.

Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tang and Fernandes, further in view of Hogan.

We refer to the final rejection (Paper No. 7) (pages referred to as "FR__") and the examiner's answer (Paper No. 12) for a statement of the examiner's rejection, and to the brief (Paper No. 11) (pages referred to as "Br__") and reply brief (Paper No. 13) (pages referred to as "RBr__") for a statement of appellants' arguments thereagainst.

OPINION

The rejection and arguments

The claims stand or fall together with claim 1 (Br7).

The examiner finds (FR2, EA4) that Tang teaches the step of "displaying a communications interface in association with a window, the interface including an icon representing a potential object recipient." We agree. For example, the gallery window 10

in Fig. 1A is broadly part of a communications interface and shows icons representing persons who are potential object recipients. Also, the chat room window 30 in Fig. 5 is for communication and shows icons of the persons in the chat room. The glance window 19 in Fig. 3 has an object portal 23 to allow participants to pass data and panels 21 which show video stream data for the participants (col. 8, lines 29-51), but the panels are not icons as in Figs. 1A and 6.

The examiner finds that Tang teaches "enabling an object to be transferred to the recipient by dragging-and-dropping a representation of the object to the icon" (FR2; EA4). We disagree. A user in Tang transfers objects by dragging and dropping them onto an object shelf, e.g., (col. 9, lines 37-54; col. 10, lines 9-36), not by dragging and dropping them onto an icon of the person. Nevertheless, transferring information by dragging and dropping an object onto an icon representing an object recipient is expressly taught by Fernandes. Fernandes describes sending a document to a person. The document and the person are each represented by an icon and the document is sent by dragging and dropping the document icon onto the person icon. Fernandes states (col. 11, lines 35-42):

Once a document has been created and it is stored, a second icon 42 is displayed on the display 50. To route the created or stored document, such as document 42A to a desired individual, the user simply clicks or activates the desired second icon or document 42A through the use of the mouse 20. The document 42A is then dragged and

Appeal No. 2004-1673
Application 09/641,431

superpositioned over the desired first icon 40,
representative of the individual to whom the document is to
be routed.

Fernandes also discloses selecting a plurality of person icons 40
and sending a document by dragging and dropping a document
icon 42 onto one of the icons 40 (col. 13, lines 1-11) and that
an information icon 42 or an action icon can be dragged and
dropped onto one of the person icons 40 "to cause information
represented by the selected desired second icon 42 to be
delivered to the desired one or more first icons 40 or to cause
the action represented by the action icon to act on the desired
one or more first icons 40" (col. 13, lines 29-33). In fact,
Fernandes teaches the subject matter of claim 1 except for the
object being in the form of a sticky note.

As to the limitation of the "sticky note," the examiner
finds that Tang teaches "enabling a user interface in the form of
a sticky note (*element 18 of fig. 1A, element(s) 26 of fig. 5 as
well as an appearance of sticky notes in figs. 1B and 3,
respectively displayed at the bottom of object 29 and 19*) to be
annotated (col. 8, lines 52-54) in order to pass a note to an
intended recipient (col. 8, lines 52-56)" (FR2; EA4).

Appellants argue (Br8): "[N]othing in Tang has anything to
do with creating a user annotatable sticky note interface. While
Tang does disclose something about allowing notes to be prepared,

Appeal No. 2004-1673
Application 09/641,431

there is no suggestion of providing a note having the appearance of a sticky note." It is argued (Br8):

In Tang, the sticky note is asserted to be the element 18. But this surely cannot be so since the element 18 is a so-called "stick-up button" which allows the current worker to create a message. See column 8, lines 54-56. Most certainly the button 18 does not constitute a sticky note. It simply is a button that can be selected to allow a current worker to create a message. But there is no reason to presume that that message would be in the form of an image of a sticky note. . . .

Absent a teaching of a sticky note, the advantageous communication protocol set forth in the current claims cannot be realized. The cited references, even when combined, would not render obvious the claimed invention.

The examiner responds (EA8-9):

Tang teaches creating a message that has text and a user has the capability of directing it to other users.... Moreover, the message is in a form representative of a note and, therefore, is a note, which a user creates and annotates (fig. 1A, element 18). Tang does not explicitly disclose the note to be "sticky"; however, Fernandes teaches a drag-and-drop method of transferring messages to an intended recipient (figs. 3-6; co. 11, lines 35-44). Therefore, it would have been obvious to an artisan at the time of the invention to include Fernandes' drag-and-drop method of transferring messages to an intended recipient to Tang's method of creating messages having the image of a note, and thus making it a sticky note in accordance with Appellant's definition, in order to facilitate users' access to data and sharing of common resources as well as to facilitate routing of messages.

Appellants reply that the examiner is incorrect in indicating that simply creating a message having an image of a note and dragging and dropping it makes the note a sticky note and is incorrect in indicating that this is in accordance with

appellants' definition of a sticky note. It is argued (RBr1):
"To the contrary, in the specification at page 6, lines 9-13, a sticky note is carefully explained. It is basically a small sheet of note paper with an adhesive upper edge so that it can be tacked onto another document. One common sticky note is the 3M Post-It brand sticky note."

Analysis

The difference between Fernandes and the subject matter of claim 1 is that the information in claim 1 is represented as a "sticky note," whereas the information in Fernandes is represented as an icon. The issue is whether Tang discloses or suggests a "sticky note" object.

A "sticky note" is a piece of paper with an adhesive upper edge. Of course, there is no actual piece of paper or adhesive in a computer. The limitation of "a user interface in the form of a sticky note" refers to the form or appearance of the interface. In appellants' drawings, the sticky note is depicted graphically as a piece of paper which is slightly curled up at the bottom, e.g., 64 in Fig. 1. However, appellants have not specifically defined the appearance of the sticky note, nor do we think that the appearance is subject to protection in a utility patent. In our opinion, any text area of relatively small size on a display which can be moved around (due to its sticky nature) can be considered a sticky note.

Tang teaches (col. 8, lines 52-56):

Referring again to FIG. 1, from the gallery window 10 the stick-up button 18 allows the current worker to create a message that may include text, recorded audio or video or the like, and direct that message to one or more workers selected from the displayed icons 14, 17. [Emphasis added.]

We find that the term "stick-up" refers to the function of the button, to create a "stick-up" message, just as the term "contact" button 16 refers to the function of making contact with one or more of the workers (col. 7, line 65, to col. 8, line 10). A "stick-up" message reasonably suggests a "sticky note." The message created by button 18 is at least a "note," as stated by the examiner, and we think that any note on the screen can be considered a "sticky note" because all objects on a display screen (icons, windows, dialog boxes, etc.) can be moved around as if they had adhesive.² Fernandes describes sending a document to a person by dragging and dropping a document object in the form of an icon onto a person icon. We conclude that it would have been obvious for the document object in Fernandes to have the form of a "sticky note" object as suggested by Tang, instead

² It is noted that "sticky notes" were well known in the art before appellants' filing date as evidenced by Lonnie E. Moseley and David M. Boodey, Mastering Microsoft Office 97 Professional Edition (2d ed. Sybex 1997), page 758 (Notes Icon in Outlook: "Lets you post small, miscellaneous notes in the Notes folder, much like jotting down quick thoughts or reminders on sticky notes.") and pages 805-806 (page 805: "Outlook has taken the basic Post-it® note functionality and implemented it in the Notes folder.") (copy attached). It would have been more persuasive for the examiner to rely on such a reference to show computer equivalents of sticky notes.

Appeal No. 2004-1673
Application 09/641,431

of an icon object representing the note, since these are two known forms to represent a document object. Accordingly, we sustain the rejection of claims 1-6, 10-16, and 20-30.

NEW GROUND OF REJECTION

Claims 29 and 30 are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter. The interface relates to the appearance and the look-and-feel to a user, and does not constitute a physical interface, such as a display screen, although it could, of course, be displayed on a display screen. An "interface" does not fit within any of the four statutory categories of patentable subject matter of § 101. An interface is clearly not a process, a machine, or a composition of matter under § 101. An interface does not constitute a physical "manufacture" under § 101. As stated in Diamond v. Chakrabarty, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980):

[T]his Court has read the term "manufacture" in § 101 in accordance with its dictionary definition to mean "the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery." American Fruit Growers, Inc. v. Brogdex Co., 283 U.S. 1, 11 (1931).

An interface must be claimed as a process, a system, or a medium containing instructions for performing the functions of the interface.

Appeal No. 2004-1673
Application 09/641,431

CONCLUSION

The rejections of claims 1-6, 10-16, and 20-30 are sustained.

Claims 29 and 30 have been rejected under a new grounds of rejection.

This decision contains new grounds of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gas. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Appeal No. 2004-1673
Application 09/641,431

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED - 37 CFR § 41.50(b)

JAMES D. THOMAS
Administrative Patent Judge

Gerry Smith
JERRY SMITH
Administrative Patent Judge


LEE E. BARRETT
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

• Appeal No. 2004-1673
• Application 09/641,431

Timothy N. Trop
Trop Pruner & Hu PC
Suite 100
8554 Katy Freeway
Houston, TX 77024